UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/806,928	03/23/2004	Jeff Mastro	15436.867.1.1	2887

22913 7590 03/17/2008

WORKMAN NYDEGGER
60 EAST SOUTH TEMPLE
1000 EAGLE GATE TOWER
SALT LAKE CITY, UT 84111

EXAMINER	
MASKULINSKI, MICHAEL C	
ART UNIT	PAPER NUMBER
2113	

MAIL DATE	DELIVERY MODE
03/17/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/806,928	MASTRO, JEFF	
	Examiner	Art Unit	
	Michael C. Maskulinski	2113	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,9-13 and 15-18* is/are rejected.

7)☒ Claim(s) *7,8 and 14* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *23 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Non-Final Office Action

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1, 4, 5, 7, 8, 12, 14, and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4, 6, 8, and 11 of U.S. Patent No. 6,745,351. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim(s) 1, 4, 6, 8, and 11 of U.S. Patent No. 6,745,351 contain(s) every element of claim(s) 1, 4, 5, 7, 8, 12, 14, and 17 of the instant application and as such anticipate(s) claim(s) 1, 4, 5, 7, 8, 12, 14, and 17 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at

896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3, 6, 10-13, 15, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Hauge, U.S. Patent 4,949,252.

Referring to claims 1 and 12:

a. In column 4, lines 22-24, Hauge discloses that signal lines which are monitored by channel interface may be selectively transferred into a cache

memory via a data bus. Cache memory is a high-speed memory which is capable of receiving and storing data samples at high data rates (a protocol analyzer operably connected to the computer network and having a trace memory in which trace data from the computer network is selectively stored).

b. In column 17, lines 49-53, Hauge discloses that during the time that a sampling run is being executed the channel interface continually monitors the signals to which it is connected, and periodically receives and transmits signal information of interest into cache memory. Cache memory in turn forwards the signal information of interest into FIFO, and the FIFO under the control of the system controller transfers the information into large store memory (hardware circuitry that selectively identifies locations in the trace memory of desired portions of the trace data).

c. In column 18, lines 31-32, Hauge discloses that the channel data is organized into segments as shown in Fig. 6 (and a processor that utilizes the locations identified by the hardware circuitry to generate an index for the trace data stored in the trace memory).

Referring to claim 2, in column 18, lines 13-18, Hauge discloses the system organizes and presents the data to the operator in a fashion which enables the operator to quickly scan the sampled data (wherein the hardware circuitry is a hardware search engine operably connected to the trace memory).

Referring to claim 3, in Figure 1, Hauge discloses that the protocol analyzer includes the hardware circuitry and the processor as part of the protocol analyzer.

Referring to claim 6, in column 18, lines 31-32, Hauge discloses that the channel data is organized into segments as shown in Fig. 6 (wherein the hardware circuitry receives from the processor specified time intervals and the hardware circuitry utilizes the specified time intervals to identify the desired portions of the trace data).

Referring to claims 10 and 15, in column 17, lines 56-61, Hauge discloses that the processor automatically initiates generation of the index upon completion of a trace.

Referring to claims 11 and 16, in column 19, lines 17-26, Hauge discloses organizing the data collected by sample number and sample interval (wherein the hardware circuitry searches for a first time stamp encountered in each of a series of blocks of trace data in the trace memory and the processor utilizes the first time stamps to build a time index for the series of blocks of trace data).

Referring to claim 13, in column 19, lines 17-26, Hauge discloses organizing the data collected by sample number and sample interval (wherein the desired portions are on specified time intervals representing different durations from a given triggering event associated with the trace data stored in the trace memory and the index that is generated is a time index).

5. Claims 1, 4, 5, 9-13, and 15-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Trcka et al., U.S. Patent 6,453,345 B2.

Referring to claims 1 and 12:

a. In column 2, lines 24-28, Trcka et al. disclose that the system continuously captures all valid data-link-level packets and routes this traffic (together with date/time stamps) to a high capacity, non-volatile data recorder (a protocol

analyzer operably connected to the computer network and having a trace memory in which trace data from the computer network is selectively stored).

b. In column 3, lines 30-48, Trcka et al. disclose being able to playback events and filter events (hardware circuitry that selectively identifies locations in the trace memory of desired portions of the trace data and a processor that utilizes the locations identified by the hardware circuitry to generate an index for the trace data stored in the trace memory).

Referring to claims 4 and 9, in column 16, lines 44-55, Trcka et al. disclose analyzing a header portion of a packet (wherein the computer network is a storage channel network and the trace data comprises frames of packetized data having a header portion and a data portion and the protocol analyzer analyzes the header portion to determine an activity associated with the frame).

Referring to claim 5, in column 5, lines 50-58, Trcka et al. disclose (wherein the storage channel network uses a Fibre Channel communication interface protocol).

Referring to claim 13, in column 16, lines 53-55, Trcka et al. disclose that the desired portions are on specified time intervals representing different durations from a given triggering event associated with the trace data stored in the trace memory and the index that is generated is a time index.

Referring to claims 10 and 15, in column 16, lines 53-55, Trcka et al. disclose that the generation of the index is automatically initiated upon completion of a trace.

Referring to claims 11, 16, and 18, in column 17, lines 48-51, Trcka et al. disclose that the hardware circuitry searches for an initial time stamp encountered in

each of a series of blocks of trace data in the trace memory and the initial time stamps are utilized to generate a time index for the series of blocks of trace data.

Referring to claims 1 and 12:

a. In column 2, lines 24-28, Trcka et al. disclose that the system continuously captures all valid data-link-level packets and routes this traffic (together with date/time stamps) to a high capacity, non-volatile data recorder (captured trace data from a computer network using a protocol analyzer operably connected to the computer network; selectively storing time stamps with the trace data).

b. In column 3, lines 30-48, Trcka et al. disclose being able to playback events and filter events (using hardware circuitry to identify locations in the trace memory of trace data associated with selected time stamps; and utilizing the locations identified by the hardware circuitry to generate a time index for the trace data stored in the trace memory).

Allowable Subject Matter

6. Claims 7, 8, 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Maskulinski whose telephone number is (571)272-3649. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Beausoliel can be reached on 571-272-3645. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael C Maskulinski/
Primary Examiner, Art Unit 2113